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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,291	10/31/2003	Jong Rak Lim	0630-1856P	8454

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*epw*

**Office Action Summary**

Application No.

10/697,291

Applicant(s)

LIM ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/347,388.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-31-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

It is noted that a certified English translation of the priority document 28766 and 28824 filed July 15, 1998 and July 16, 1998 have been received within the parent application (SN 10/337,999).

This application being examined (SN 10/697,291) is a continuation of Patent Application Serial Number 10/337,999, filed January 8, 2003, now U.S. Patent No. 6,757,240, which is a continuation of Patent Application Serial Number 09/347,388, filed July 6, 1999, now U.S. Patent No. 6,529,471.

### ***Election/Restrictions***

Applicants' election with traverse of Species I, Figure 7, which Applicants state are "readable on claims 1-7" in the reply filed on October 13, 2004 is acknowledged. The traversal is on the ground(s) that:

The present application contains a reasonable number of species. Further, examination of all of the species together in one application would not place an undue burden on the Examiner. It is respectfully submitted that the Examiner's Election of Species Requirement is improper in view of the fact that a reasonable number of species are set forth in the present application.

See page 11 of Applicants' response and amendment filed October 13, 2004.

This is not found persuasive because the Examiner steadfastly maintains that the search for multiple species, without an allowable generic claim, would indeed impose a harsh and administrative burden upon the Examiner.

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Additionally, it is noted that the Applicants did not traverse on the ground that the species are not patentably distinct. If the Applicants were to traverse on the ground that the species are not patentably distinct, the Applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. If the Applicants were to include such a statement, the election requirement would be withdrawn. In either instance, however, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 8-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 13, 2004.

This application contains claims 8-16 drawn to an invention nonelected with traverse in the response filed October 13, 2004. The Applicants are advised that a complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

### *Claim Objections*

Claims 1, 4 and 7 are objected to because of the following informalities:

With regard to claim 1 (line 6), the word "to" should be changed to the word --for--.

With regard to claim 1 (line 9), the word -- a -- should be inserted before the phrase "data

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processor.”

With regard to claim 4 (line 6), the word “to” should be changed to the word --for--.

With regard to claim 4 (line 9), the word -- a -- should be inserted before the phrase “data processor.”

With regard to claim 4 (line 15), the phrase “the first side” should be changed to the phrase --a first side--.

With regard to claim 7 (line 2), the word “t he” should be changed to the word -- the --.

Appropriate correction is required.

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “51” has been used to designate both the optical pick-up unit and the optical pick-up transport unit. See Figure 11 and specification paragraph [079].

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities:

With regard to paragraph [001], the current status of co-pending Application No. 10/337,999 should be updated by adding the phrase --which is now U.S. Patent No. 6,757,240-- after the phrase "filed on January 8, 2003,".

With regard to paragraph [079] (lines 3-4 of paragraph [079]) of the instant specification, the phrase "an optical pick-up unit transport the optical pick-up unit," should be amended to read -- an optical pick-up unit transporting the optical pick-up unit, -- or similar language.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 sets forth "a servo unit to control the recording/reading unit."

The original disclosure, including the drawings fails to disclose any such servo unit functioning in the manner as set forth in claim 1, in combination with the claimed protection

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casing used in the device for recording or reproducing data.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 6,757,240 in view of Shigematsu et al. (US 5,668,787).

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 6,757,240 in view of Kuwa (JP 10-144031) and Shigematsu et al. (US 5,668,787).

US Patent No. 6,757,240 claims the subject matter of claims 1-7 including a disk (recording medium) protection casing, comprising: a casing body having a receiving space therein and an access port formed in a first side of the casing body; and a holder insertable into an interior of the casing body via the access port, and one of the recording medium holder and the first side of the casing body being structured such that the disk (recording medium) holder is prevented from being incorrectly inserted into the casing body,

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the holder including an elastic member for supporting a disk therein and for releasing the disk into the receiving space (e.g., see claim 1 of US Patent No. 6,757,240).

US Patent No. 6,757,240, however, does not explicitly claim wherein a guide member is formed at an outer portion of the receiving space, and a shoulder is formed at a side of the elastic member for rotatably releasing the recording medium into the receiving space upon contact by the shoulder with the guide member (as per claim 1).

Kuwa (JP 10-144031) discloses a conventional disk cartridge wherein a disk holder (10) having a pair of elastic arms (12, 12) releases a disk upon insertion into a disk cartridge, wherein a guide member (16) is formed at an outer portion of the disk receiving space, and a shoulder (distal end portion of (12)) is formed at a side of the elastic member (12, 12) for rotatably releasing the recording medium (2) into the receiving space upon contact by the shoulder (distal end portion of (12)) with the guide member (16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the claim scope coverage (by claiming in US Patent No. 6,757,240) the particular guide member interacting with the elastic arms, as disclosed by Kuwa (JP 10-144031).

The rationale is as follows: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the claim scope coverage (by claiming in US Patent No. 6,757,240) the particular guide member interacting with the elastic arms, as disclosed by Kuwa (JP 10-144031) in order to readily release the disk medium in a reliable manner, as exemplified by the very analogous disk cartridge of Kuwa (JP 10-144031).

Additionally, with regard to claims 1 and 4, US Patent No. 6,757,240 does not explicitly claim a receiving unit, recording/reading unit, servo unit, data processor and controller,



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interface unit and host as set forth in claim 1 of the instant application (as per claims 1 and 4).

Shigematsu et al. (US 5,668,787), however, discloses, *inter alia*, a disc recording/reproducing device including a receiving unit (FIG. 1), recording/reading unit (107), servo unit (207), data processor (208), controller (209), interface unit and host (connected via the HOST INTERFCAE) as seen in FIG. 13, as set forth in claim 1 of the instant application (as per claims 1 and 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the claim scope coverage (by claiming in US Patent No. 6,757,240) the particular components of a conventional disk device as set forth in claim 1 and 4, as exemplified by Shigematsu et al. (US 5,668,787).

The rationale is as follows: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the claim scope coverage (by claiming in US Patent No. 6,757,240) the particular components of a conventional disk device as set forth in claim 1 and 4, as exemplified by Shigematsu et al. (US 5,668,787) in order to process the data from the optical disc in a conventional manner, as is well known, established and appreciated in the art as disclosed by Shigematsu et al. (US 5,668,787).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

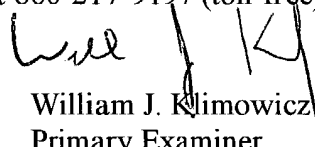
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-

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3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William J. Klimowicz  
Primary Examiner  
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WJK